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Filing date: **11/17/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|------------------------|---|
| Proceeding | 91194262 |
| Party | Plaintiff Act II Jewlery, Inc. d/b/a lia sophia |
| Correspondence Address | Milton Springut KALOW & SPRINGUT LLP 488 Madison Avenue New York, NY 10022 UNITED STATES ms@creativity-law.com, tbenschar@creativity-law.com |
| Submission | Motion to Compel Discovery |
| Filer's Name | Tal S. Benschar |
| Filer's e-mail | tbenschar@creativity-law.com |
| Signature | /Tal S. Benschar/ |
| Date | 11/17/2010 |
| Attachments | Motion to Compel.pdf (11 pages)(285967 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ACT II JEWELRY, LLC d/b/a lia sophia,

Opposer,

Opposition No. 91194262

v.

Serial No.: 77/877396

MARY KAY, INC.

Mark: SHARE THE LOVE

Applicant.

**OPPOSER'S MOTION TO COMPEL INITIAL DISCLOSURES
AND RESPONSES TO DOCUMENT REQUESTS AND INTERROGATORIES**

Opposer Act II Jewelry, LLC d/b/a lia Sophia ("Opposer") hereby moves to compel applicant Mary Kay, Inc. ("Mary Kay") to provide initial disclosures and responses to outstanding discovery requests. Opposer relies upon the Memorandum of Law and Declaration of Tal S. Benschar annexed hereto below.

MEMORANDUM OF LAW

A. Initial Disclosures

The current schedule required the parties to serve initial disclosures by August 1, 2010. To date, Applicant has failed to serve initial disclosures, although they were demanded both during a phone conference held on November 9, 2010 as well as by letter dated November 10, 2010. (Benschar Decl. ¶ 4 and Exh. B)

B. Responses To Document Requests and Interrogatories

Opposer served discovery requests (interrogatories and document requests) upon Applicant's counsel on September 8, 2010. Shortly before the responses to the discovery were due, Applicant requested an extension because it claimed that the requests had been misplaced by a secretary. Opposer granted Applicant a four-week extension, to November 10, 2010. Yet to date no responses have been forthcoming. (Benschar Decl. ¶ 2-3 and Exh. A)

In a phone conference on November 9, 2010, Applicant proffered two excuses for these deficiencies. First, it noted that it had in the interim requested that Opposer consider using the Board Accelerated Case Resolution procedure. Opposer considered that request, and rejected it. In any event, that the parties are discussing using that procedure is not a basis to extend discovery responses, and we are aware of no such basis in the rules.

Second, Applicant noted that the parties did not hold their initial discovery conference until November 9, 2010. This deficiency, Applicant claimed, relieved it from the obligation of answering discovery, and, so it argued, extended the time to respond until 30 days after the conference. This argument should be rejected. Although Trademark Rule 2.120 does provide that initial disclosures must be served before discovery requests are served, 37 C.F.R. 2.120(a)(3), there is no such provision as to the discovery conference. And, while Rule 26 of the Federal Rules of Civil Procedure does contain such a provision, that aspect of the federal rules is only applicable in Board proceedings "in modified form, as noted in these rules." *Id.* § 2.120(a)(1). As noted, Trademark Rule 2.120 contains no provision

limiting service of discovery, and indeed the TBMP expressly provides that document requests and interrogatories “may be served on an adversary from the day the discovery period opens through the last day of the discovery period . . .” TBMP § 403.02.

Additionally, it is well-established that the holding of a discovery conference is a mutual responsibility, *see Influence, Inc. v. Zuker*, 88 U.S.P.Q.2D 1859 n. 2 (TTAB 2008), unlike initial disclosures as to which each party is responsible for its own disclosures. Thus, Opposer and Applicant are equally at fault for holding a late discovery conference. That should not be the basis for Applicant to avoid its other discovery obligations.

Furthermore, even if the Board holds that, in general, the failure to hold a discovery conference is reason to avoid answering discovery, in this case Applicant has waived any such procedural protections. As noted, Applicant contacted Opposer only a few days before its responses were due and, based upon a claim of misplacing the requests, Opposer consented to a *four-week* extension. At the time, Applicant made no mention of the need for a discovery conference; it instead obtained a nearly one-month delay based on its claim of misplacing the requests and now claims that in reality it was never obligated to repond at all. Such bait-and-switch tactics should not be countenanced.

CONCLUSION

It is respectfully requested that the Board issue an order requiring Applicant to serve initial disclosures and responses to the outstanding discovery requests forthwith.

Respectfully submitted,

KALOW & SPRINGUT LLP
488 Madison Avenue
New York, New York 10022
Tel: (212) 813-1600

*Attorneys for Opposer
Act II Jewelry, LLC*

Dated: November 17, 2010

By: _____


Milton Springut
Tal S. Benschar

DECLARATION OF TAL S. BENSCHAR

TAL S. BENSCHAR declares:

1. I am a partner with Kalow & Springut LLP, counsel for Opposer Act II Jewlery, LLC ("Opposer"), in the above proceeding. I make this declaration in support of Opposer's motion to compel discovery.

SERVICE OF DISCOVERY REQUESTS

2. On September 8, 2010, our office served Interrogatories and Document Requests upon Applicant. To date, no response has been received.

3. On or about October 7, 2010, I was contacted by counsel for applicant Mary Kay, Inc. She explained that she was inquiring about obtaining an extension on the discovery requests, because an assistant in her office had misfiled the requests and counsel had not been made aware of them until then. By email dated October 8, 2010, we agreed to extend the response time by four weeks until November 10, 2010. A copy of such email is attached as Benschar Declaration Exhibit A.

INITIAL DISCLOSURES

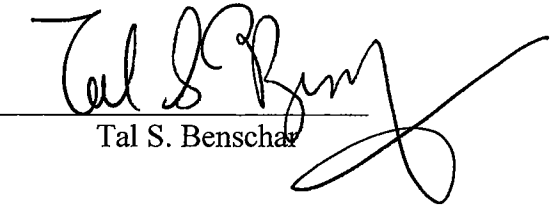
4. Applicant has to date never served initial disclosures, although they were due on August 1, 2010. A demand for same was made during a phone conference held among counsel on November 9, 2010 and again by letter dated November 10, 2010. A copy of the November 10, 2010 letter is attached as Benschar Declaration Exhibit B.

ATTEMPT TO CONFER ON THE MOTION

5. Our office conferred with Applicant's counsel on the issues raised in the instant motion by phone conference held on on November 9, 2010 and again by letter dated November 10, 2010.

6. I declare under penalty of perjury that the foregoing is true and correct.

Date: November 17, 2010
New York, New York


Tal S. Benschar

BENSCHAR DECLARATION

EXHIBIT A

Benschar, Tal S.

From: Benschar, Tal S.
Sent: Friday, October 08, 2010 2:10 PM
To: 'agroos@fulbright.com'
Cc: Springut, Milton; 'rgroos@fulbright.com'
Subject: ActII v. Mary Kay

Dear Ms. Groos:

I discussed your requests with Milton. We agree to a 60-day extension of the discovery period. Please file the appropriate motion with the Board (which is now automated) with our consent.

With regards to the outstanding document requests, we would agree to a four-week extension. Your client's responses are currently due October 13, 2010, so they will now be due November 10, 2010.

Please let me know if you need anything else.

Sincerely,



Tal Benschar
Kalow & Springut LLP
488 Madison Avenue, 19th Floor
New York, New York 10022
T: (212) 813-1600
F: (212) 813-9600
E: tbenschar@creativity-law.com

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11/15/2010

BENSCHAR DECLARATION

EXHIBIT B



KALOW & SPRINGUT LLP

ATTORNEYS AT LAW

VIA EMAIL

November 10, 2010

Alicia Morris Groos, Esq.
Fulbright & Jaworski L.L.P.
600 Congress Avenue, Suite 2400
Austin, TX 78701

Re: *ACT II Jewelry, LLC v. Mary Kay, Inc.*
Opposition No. 91194262

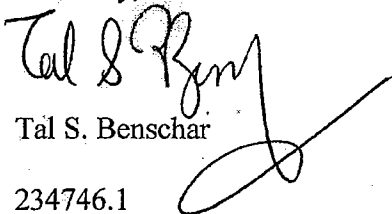
Dear Ms. Gross:

Following up on our discussion at yesterday's conference, we do not agree with your position regarding Opposer's outstanding discovery requests, for the reasons stated at the conference. We have been more than generous in providing a four-week extension on the discovery requests. No additional extension is warranted.

In addition, we note that your client's initial disclosures were due on August 1, 2010 and are now seriously overdue. Please provide same forthwith or we will be forced to move to compel.

On a separate matter, we have discussed extending the discovery period by 60 days. We can file the extension through our office or you can do so. You indicated that you need to obtain your client's authority to file such a motion. Please provide your client's position by next week.

Sincerely,


Tal S. Benschar

234746.1

DECLARATION OF SERVICE

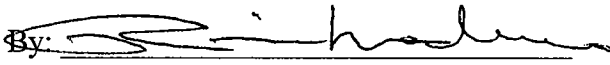
ROSEMARIE MADURO declares that:

1. I am an assistant with KALOW & SPRINGUT LLP, attorneys for the Opposer in the captioned proceeding, and that on the execution date which appears below, a true copy of the annexed **OPPOSER'S MOTION TO COMPEL INITIAL DISCLOSURES AND RESPONSES TO DOCUMENT REQUESTS AND INTERROGATORIES** was served via email and U.S. Mail upon the following addressee:

Alicia Morris Groos, Esq.
Fulbright & Jaworski L.L.P.
600 Congress Avenue, Suite 2400
Austin, TX 78701
'agroos@fulbright.com'

2. Pursuant to 28 U.S.C. § 1746, I declare under penalty of perjury that all of the foregoing is true and correct.

Executed on November 17, 2010
New York, New York

By: 
Rosemarie Maduro